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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,266	01/14/2004	George Koutlakis	030901	4897

26285 7590 05/22/2006

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EXAMINER	
MARCHESCHI, MICHAEL A	
ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 05/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/757,266	KOUTLAKIS ET AL.	
	Examiner	Art Unit	
	Michael A. Marcheschi	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) *1-14 and 33-46* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-32 and 47-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 47-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims define that the media is used as an agitating media, however, claims 15, 16 and 28, which these claims depend from, already define that the media is an agitating media, thus claims 47-49 are defining subject matter already defined by the independent claims. In view of this, the subject matter of claims 47-49 are indefinite as to the duplicate subject matter.

Claims 15-32 are rejected under 35 U.S.C. 103(a) as obvious over Koutlakis et al. (257) in view of Rosenflanz and Blanton et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claims 47-49 are rejected under 35 U.S.C. 103(a) as obvious over Koutlakis et al. (257) in view of Rosenflanz and Blanton et al. because the combination, as defined in the previous office action, clearly makes agitating (milling) media obvious. In addition, these claims are defining the intended use of the material and the intended use gives no patentable weight to the material.

Claims 15, 17, 18, 20, 22, 24 and 26-27 are rejected under 35 U.S.C. 103(a) as obvious over Lane et al. (068) in view of Rosenflanz and Blanton et al. for the same reasons set forth in the previous office action which are incorporated herein by reference.

New claim 47 is rejected under 35 U.S.C. 103(a) as obvious over Lane et al. (068) in view of Rosenflanz and Blanton et al. because the combination, as defined in the previous office action, clearly makes agitating (milling) media obvious. In addition, these claims are defining the intended use of the material and the intended use gives no patentable weight to the material.

Claims 16, 19, 21, 23, 25 and 27-32 are rejected under 35 U.S.C. 103(a) as obvious over Lane et al. (068) in view of Koutlakis et al. and further in view of in view of Rosenflanz and Blanton et al. for the same reasons set forth in the previous office action which are incorporated herein by reference

New claims 48 and 49 are rejected under 35 U.S.C. 103(a) as obvious over Lane et al. (068) in view of Koutlakis et al. and further in view of in view of Rosenflanz and Blanton et al. because the combination, as defined in the previous office action, clearly makes agitating (milling) media obvious. In addition, these claims are defining the intended use of the material and the intended use gives no patentable weight to the material.

Applicant's arguments filed 4/24/06 have been fully considered but they are not persuasive.

At the onset of the response, applicants state that the declaration filed 4/24/06 addresses the central argument of the obvious rejections. The examiner acknowledges this declaration, however, this declaration is not convincing because it is an opinion declaration. In addition, the declaration implies that the references are directed **only** to blasting media. The examiner is aware of the teachings of the references that define blasting media, however, as defined previously, the references are not only limited to blasting media because Lane et al. (068)

teaches an **example** of abrasive application in column 4, lines 9+ and prior to this passage (lines 7-8), the reference states that the particles can be used in abrasive applications (i.e. this does not limit the reference to blasting media, but rather implies any abrasive application). In addition, claim 1 of this reference only defines "grit" and also does not limit the claim to blasting media. "**A reference can be used for all it realistically teaches and is *not* limited to the disclosure in its preferred embodiments (i.e. example)" See *In re Van Marter*, 144 USPQ 421.** Although Koutlakis et al. only suggest blast media in the **examples** (reference is not limited to the examples), the claims of the reference do not limit the application, and as defined in the above rejection, the use of this grit as a milling (agitating) media would have been appreciated by the skilled artisan. In addition, column 5, lines 50-51 of this reference states that the invention is based on **abrasive grits** and that the solid material can be ground to an **appropriate** size. The broad interpretation of this is that the solid material can be ground to an appropriate size **depending on its application**. Following this statement is the criteria that the abrasive grit is used as blasting media. This criteria can be considered a preferred embodiment and if the reference was only limited to blasting media, why **doesn't** claim 1 define a method for producing blasting media? To the contrary, the claim defines a method for producing abrasive grit and the interpretation of abrasive grit is much broader than a basting media (i.e. abrasive media can encompasses a tumbling media). In addition, when blasting media is defined in column 5, lines 53-54, the reference states that the abrasive grit is adapted to be used as a blasting media and this is **not** a positive limitation that the abrasive grit is a blasting media. "Adapted to be" does not limit the reference only to the defined application. The declaration also states that the blasting compositions of the primary references are unsuitable for agitating media because of clumping.

This statement relies on the presumption that the references only teaching blasting media, however, as clearly defined above, the references are not limited to these applications. In addition, the declaration does not addressed the combination as applied.

Applicants also state that the examiner acknowledges that both primary references disclose only polysaccharide **blasting media.** The examiner has not made this acknowledgement but has previously defined that the references teach abrasive grits and the broad generic interpretation of "abrasive grits" does **not** limit the references to only blasting media.

Applicants argue that there is not motivation to combine the references. The examiner disagrees because Lane et al. (068) teaches that the particles can be used in abrasive applications (i.e. this does not limit the reference to blasting media but rather implies any abrasive application). This statement, alone, provides the necessary motivation for the combination. With respect to Koutlakis et al., column 5, lines 50-51 of this reference, states that the invention is based on **abrasive grits** and that the solid material can be ground to an **appropriate** size. The broad interpretation of this is that the solid material can be ground to an appropriate size **depending on its application**. This statement, alone, provides the necessary motivation to use the abrasive grit of the reference in any abrasive application. In addition, the independent claim in both references defines abrasive grit particles, in the broadest sense, and this also, provides the necessary motivation to use the abrasive grit of the references in any abrasive application.

Applicants also state that it is improper to combine the references if the proposed modification would render the prior art being modified unsatisfactory for its intended use. The examiner is aware of this, however, applicants appear to be focusing on the references intended

use being only limited to blasting media. As clearly defined above, the references are **not** only limited to blasting media, but rather abrasive grit, in general, (i.e. see the independent claims of the reference, as well as, the other teachings above). In view of this, the examiner is unclear as to how the modification proposed by the examiner renders the prior art unsatisfactory for abrasive applications.? Why are the references only limited to blasting media? Applicants provide no clear evidence to support the arguments based on the limiting argument (limited to only blasting media). The references never define or imply that they are only limited to blasting media but rather imply that this is a possible use. One skilled in the art would have appreciated from the references, as a whole, that they can be use in any abrasive applications.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Marcheschi whose telephone number is (571) 272-1374. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/06
MM

Michael A Marcheschi
Primary Examiner
Art Unit 1755